

REMARKS

At the time of the Office Action dated November 21, 2005, claims 1-12 were pending and rejected in this application.

On page 2 of the Office Action, the Examiner objected to the Abstract. In response, Applicants have amended the Abstract to delete the first sentence. Therefore, Applicants respectfully solicit withdrawal of the imposed objection.

**CLAIMS 1-4 AND 7-10 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED
BY KIMOTO ET AL., U.S. PATENT NO. 6,829,484 (HEREINAFTER KIMOTO)**

On pages 3-5 of the Office Action, the Examiner asserted that Kimoto discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met.

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

Independent claims 1 and 7 recite:

responsive to receiving a network request for location-based processing from a pervasive device, storing said received network request and forwarding said received network request to a selected location-based application (emphasis added)

To teach the claimed "storing said received network request," the Examiner referred to S35 of Figure 20. Step "S35" is not present in Figure 20, but Applicants proceed on the basis that the Examiner intended to refer to step S25. This step is described in column 37, lines 35-37, which states that "[t]he information center 5 receives the information (Step S24), and accumulates and stores it in the database 52 (Step S25)." The "information" referred to by Kimoto, however, is not a network request. Instead, the information being stored is "map information or town information" (column 37, lines 30-37).

The Examiner also refers to steps S3 and S5 to teach the claimed "forwarding said network request." However, steps S3 and S5 of Kimoto also do not disclose forwarding a network request. Instead, the information being forwarded is position information. Therefore, Kimoto fails to identically disclose the claimed features of "storing said received network request and forwarding said received network request."

Claims 1 and 7 also recite "locating said required location information from within said stored network request" (emphasis added). Therefore, this step refers back to the "stored network request" described above, which the Examiner asserted is disclosed in Figure 20 as S35 (or S25). Claims 1 and 7, therefore, require that the received network request that is stored be

the same as the network request that is used to locate the required location information. The Examiner, however, has not established that Kimoto discloses this feature.

With regard to the "locating said require location information ...", the Examiner asserted that this feature is disclosed in C6 of Figure 45, which states "the user inputs the current position by selecting one of the reported landmarks on the display" (see also column 49, lines 61-67). This passage within Kimoto, however, is complete silent with regard to the feature that the Examiner initially asserted identically disclosed the claimed "storing said received network request." Instead, what the Examiner asserts to be the "received network request" is different in Figure 20 than Figure 45.

Thus, Kimoto fails to identically disclose the claimed invention, as recited in claims 1 and 7, within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-4 and 7-10 under 35 U.S.C. § 102 for anticipation based upon Kimoto.

CLAIMS 5-6 AND 11-12 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS

BASED UPON KIMOTO IN VIEW OF DIEDRICH ET AL., U.S. PATENT PUBLICATION No. 2002/0199018 (HEREINAFTER DIEDRICH)

On pages 2-5 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Kimoto in view of Diedrich to arrive at the claimed invention. This rejection is respectfully traversed.

Although Applicants disagree that the claimed invention is obvious based upon the Kimoto in view of Diedrich, to expedite prosecution of the Application, Applicants submit that the reference to Diedrich cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(l).

Application No. 10/068,362 (the present application) and
U.S. Patent Publication No. 2002/0199018 (Diedrich) were, at the
time the invention was made, commonly owned by International
Business Machines Corporation

Thus, under 35 U.S.C. § 103(c), the reference to Diedrich cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that the imposed rejection of claims 5-6 and 11-12 under 35 U.S.C. § 103 for obviousness based upon the Kimoto in view of Diedrich is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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